

U.S. Patent Application No. 09/672,328
Request for Reconsideration dated June 22, 2004
Reply to Office Action dated March 22, 2004

REMARKS/ARGUMENTS

Reconsideration and continued examination of the above-identified application are respectfully requested.

At page 2 of the Office Action, the Examiner rejects claims 1-27 and 29-31 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the modified pigment product of the claimed invention has no final definitive structure or description containing all the elements, with respect to the classes of colored pigments, organic ionic groups, amphiphilic counterions, and anionic amphiphilic ions. Furthermore, the Examiner states that the specification does not specify how the pigment is connected to one steric group, one organic ionic group, and one amphiphilic counterion. Thus, the Examiner concludes that the description of the modified pigment product in the specification is inadequate. For the following reasons, this rejection is respectfully traversed.

With respect to the written description requirement, all that is required is that the subject matter of the claims that are pending are fully described in the present application as originally filed. This is further confirmed by the guidance provided to the Examiner in the MPEP as summarized below.

The written description requirement necessitates that the invention be described in such a way that it is clear that the applicant invented what is claimed. (See MPEP §2163.02) According to MPEP §2163.02, "an objective standard for determining compliance with the written description requirement is, does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." According to MPEP § 2163.02, "to satisfy the written

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description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed." MPEP § 2163.02 states that "[p]ossession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was 'ready for patenting' such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention."

As indicated above, all that is required is that the subject matter of each claim be described in the application as originally filed. As provided below, it is clear that each aspect of the claims as pending is fully described in the present application and clearly the written description requirement is satisfied.

Claim 1 of the present application recites "[a] modified pigment product comprising a pigment having attached a) at least one steric group and b) at least one organic ionic group and at least one amphiphilic counterion, wherein said amphiphilic counterion has a charge opposite to that of said organic ionic group, and wherein said pigment comprises a blue pigment, black pigment, white pigment, brown pigment, cyan pigment, green pigment, violet pigment, magenta pigment, red pigment, yellow pigment, orange pigment, shades thereof, or a combination thereof."

The claims of the present application clearly comply with the written description requirements. For example, page 5, lines 17-20, and page 13, line 14 - page 14, line 24, clearly

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indicate that the applicant had possession of the claimed invention at the time of the claimed subject matter.

With respect to the Examiner's comments that the modified pigment product has no final "definitive structure or description containing all of the elements," the applicants respectfully disagree. First of all, with respect to the written description, as stated above, all that is required is that the subject matter of the claims be described in the original application as filed to ensure that there is no new matter being introduced by the applicants. It is clear, and it appears that the Examiner fully agrees, that the subject matter of the claims was fully described in the application as originally filed. With respect to "definitive structures," there are numerous locations in the application as filed that clearly describe the structure of each component and its relationship to the pigment. For instance, at page 3, lines 15 - page 4, line 28, it is clear that the present invention as originally filed describes that the pigment has attached at least one steric group and further that the pigment has attached at least one organic ionic group. Furthermore, the present application clearly describes that at least one amphiphilic counterion is in association with the at least one organic ionic group. This application further provides numerous examples on preferred steric groups and how they are attached to the pigment. The present invention even states that, in several examples, the substituent X represents an arylene or alkylene group and that the -X is attached directly to the pigment. (See page 5, lines 25-26). In addition, examples of how the spacer group would be located in the present application are clearly described, for instance at page 7. Furthermore, with respect to the organic ionic group and the at least one amphiphilic counterion, various chemistries are specifically described at page 9, line 20, and continuing for

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many pages. Various formulas are provided. The clear arrangement of each group with respect to the pigment is provided throughout the present application, including the sections discussed above. Thus, it is not understood how the Examiner can assert that there is no written description for the claims as pending when it is clear that there is. With respect to the Examiner's comment that the skilled artisan in the art has a burden to figure out what the claimed invention is in the absence of claimed formulas, the Examiner is simply incorrect. The terms as used in the claims as pending are clearly described in the present application and these are terms that are clearly understood by one skilled in the art. The Examiner has provided no technical evidence whatsoever to justify the argument that one skilled in the art would not understand these terms. These terms are common in chemistry and have been used in the past. Furthermore, these terms are described in the present application, and one skilled in the art would clearly understand their meaning, especially in view of the present application. Accordingly, it is clear that the written description requirement has been satisfied and that this rejection should be withdrawn.

At page 3 of the Office Action, the Examiner rejects claims 1-27 and 29-31 under U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

According to the Examiner, the expressions "comprising" and "comprises" as recited in claims 1, 2, 4, 8, 9, and 20 are vague and indefinite. Additionally, with respect to claim 1, the Examiner states that the phrase "a modified pigment product comprising a pigment having attached a) at least one steric group and b) at least one organic ionic group and at least one amphiphilic counterion" is vague and indefinite. According to the Examiner, claim 1 does not

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describe how the pigment is connected to at least one steric group, to at least one organic ionic group, and to at least one amphiphilic counterion.

Additionally, with respect to claims 2, 8, 9, and 20, the Examiner states that the term "a spacer group" is vague and indefinite. The Examiner states that the claims do not recite what types of a spacer group is employed in the claimed structure. Furthermore, with respect to claims 4 and 11, the Examiner states that the term "a functional group" is vague and indefinite. The Examiner states that claims 4 and 11 do not recite what types of functional groups are employed in the claimed structure. Additionally, with respect to claim 20, the Examiner states that the term "polymer" is vague and indefinite. The Examiner states that claim 20 does not recite what types of polymers are employed in the claimed structure. For the following reasons, this rejection is respectfully traversed.

To the extent possible, the applicants will respond to this rejection. However, the Examiner's rejection, especially with respect to the use of the expressions "comprising" and "comprises" as vague and indefinite is not understood since these are legal terms which have an acceptable meaning under U.S. patent laws.

With respect to the expressions, "comprising" and "comprises," these terms have long been recognized in patent law and are considered to be definite. (See MPEP §2111.03).

With respect to the Examiner's comments that the expression "a modified pigment product" would mean a single product, this part of the rejection is not understood. Claim 1 recites a modified pigment product comprising . . . This clearly means that the modified pigment product contains the recited ingredients set forth in claim 1 and any unrecited component. It is

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clear that claim 1 is written to state that the modified pigment product contains the recited components. There is nothing indefinite with respect to claim 1.

With respect to the Examiner's statements that claim 1 is vague and indefinite, one skilled in the art, by reading claim 1 in view of the present specification, can clearly understand how the pigment is connected to at least one steric group, and also to at least one organic ionic group, which in turn is associated with at least one amphiphilic counterion. As indicated above, the present application in numerous locations describes the arrangement of the various components that make up the modified pigment product. As clearly stated in claim 1, as well as in the specification, it is clear that the at least one steric group is attached to the pigment. Furthermore, at least one organic ionic group is also attached to the pigment and that at least one amphiphilic counterion has a charge opposite to the organic ionic group and therefore would be associated with the organic ionic group. Thus, the arrangement of the various components with respect to the pigment is clearly set forth in claim 1 and is fully described in great detail in the application. *See*, for instance, page 5, line 17, et seq. As further described above, various formulas are provided and how those formulas would be attached to the pigment is even further described. For instance, see claim 2. Thus, there is nothing indefinite about claim 1 and the components recited in claim 1.

Similarly, with respect to the other claims that recite "comprising," the same comments apply. It is fully acceptable and appropriate under 35 U.S.C. §112 to recite a printing plate comprising various components and it is further appropriate and proper to recite "a radiation-adsorptive layer comprises" The Examiner's comments that the expression of a "printing

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plate" would mean a single product is not understood. A particular plate is being recited in claim 29 and that plate comprises various components. This clearly would be understood by one skilled in the art and the Examiner has not provided any technical concrete reasons why these claims would be indefinite. The same would be true for the remaining subparts of this rejection where the term "comprises" is used.

With respect to the term "a spacer group," one skilled in the art, by reading claims 2, 8, 9, and 20 in view of the present specification, would clearly understand the meaning of the term "a spacer group." Furthermore, the present specification, at page 6, provides several examples of spacer groups.

With respect to the term "functional group," one skilled in the art, by reading claims 4 and 11 in view of the present specification, specifically at page 6, lines 29 - page 7, line 3, would clearly understand the meaning of the term "a functional group."

With respect to the term "polymer," one skilled in the art, by reading claim 20 in view of the present specification, for instance, at page 4, lines 21 and 22, and page 8, line 19 - page 9, line 19, would clearly understand the meaning of the term "polymer." Accordingly, this rejection should be withdrawn.

The Examiner is respectfully requested to contact the undersigned by telephone should there be any remaining questions as to the patentability of the pending claims.

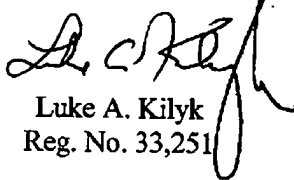
CONCLUSION

In view of the foregoing remarks, the applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

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If there are any other fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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